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EXAMINER

SOREY, ROBERT A

ART UNIT	PAPER NUMBER
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3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,633

Applicant(s)

DORFSTATTER, WALTER A.

Examiner

ROBERT SOREY

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. In the amendment filed 05/04/2009, the following occurred: claims 1 and 2 were amended. Claims 1-7 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-4** are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular **machine**) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilsky, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); and Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied. This can be done, for example, by identifying the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

Applicant's method steps in claims 1-4 fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Furthermore, the method steps fail to transform underlying subject matter to a different state or thing. For example, claim 1 teaches sensing a vehicle incident, sending data to a service center, using the data to estimate vehicle damage, and using the estimate in an insurance process; but in no way is it clear as to how this is accomplished (such as, accomplished by a particular **machine**). It is recommended that Applicant simply add any structural language from the specification as necessary to complete a statutorily compliant method having Applicant's desired capabilities.

Note: Claim number 1 includes machine parts (transceiver); however, these parts are directed towards nominal data gathering. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). See: Ex parte Lars Langemry, Magnus Markland, Arne Nordmark, Per-Olof Persson, and Magnus Ringh, Appeal No. 2008-1495, Application No. 09/675,778.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1, 2, and 5** are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Court of Appeals for the Federal Circuit has set forth a number of factors (the "*Wands* factors") to consider with regard to a lack of enablement, including:

- A. The breadth of the claims;
- B. The nature of the invention;
- C. The state of the prior art;
- D. The level of one of ordinary skill;
- E. The level of predictability in the art;
- F. The amount of direction provided by the inventor;
- G. The existence of working examples; and
- H. The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988). See MPEP § 2164.01(a)

6. As per claim 2, it is drawn to determining vehicle damage from delta velocity and vehicle information.

Factor A: The claim is overly broad, disclosing only that delta velocity is used in estimating vehicle damage.

Factor B: The invention is drawn to estimating vehicle damage by using vehicle delta velocity which is technically complex.

Factor C: The prior art cited PTO-892 show great detail demonstrating the level of ordinary skill in the art at the time the invention was made, and reveal that estimating vehicle damage from vehicle delta velocity and vehicle identification information was not well known.

Factor D: One of ordinary skill in the art must be mathematically skilled, and one of ordinary skill in the art would still not know how to estimate vehicle damage from vehicle delta velocity and vehicle identification information.

Factor E: The invention attempts to automate a manual process. Estimating vehicle damage is a subjective manual process typically done by adjustors in the insurance business or specialists in the automotive business. The prior results were unpredictable as they require imprecise human judgments.

Factor F: The inventor provides no direction. The specification refers to an "estimator" for receiving incident delta velocity and "utilizes this data along with the vehicle type information to determine an estimated damage value" by looking up the inputs in a database, but in no way is it made clear how this is done; what calculations, variables, inputs, and equations are involved; or even exactly what the variables are, except for that of delta velocity. A mere statement that it is done is insufficient to show possession.

Factor G: No working examples were provided.

Factor H: Based on the content of the disclosure, an undue amount of experimentation would be required to, in any way, estimate vehicle damage; therefore, an undue amount of experimentation would be needed to make or use the Applicant's invention.

7. As per claims 1 and 5, they are rejected similarly to claim 2, as they rely on vehicle sensors to estimate vehicle damage and are less specific.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 1, 2, and 5** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See: MPEP § 2172.01. The omitted steps are: Applicant claims using incident data to automatically estimate vehicle damage (in claim 2, incident data is delta velocity), but the steps detailing how one uses said incident data to determine vehicle damage are missing. Applicant's specification teaches only that an "estimator" makes estimate by looking up the input in a database, but no such database is known to exist, and the steps involved in looking up, calculating, and determining an estimated values based on incident data are missing.

Applicant Admitted Prior Art

10. **Note:** The MPEP states: "If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate." In the present case Official Notice was used to cover subject matter in claim 2, and in the reply filed by Applicant on 03/10/2008 and in the Appeal Brief filed 09/26/2008, no attempt was made by Applicant to traverse the official notice rejections; therefore, the material of claim 2 covered by the official notice in the office action dated 12/10/2007 is understood to be Applicant Admitted Prior Art.

11. Specifically, the limitation stated: *the claimed receiving a claim damage estimate*; and the Examiner took official notice "that an insurance carrier receiving a claim damage estimate for analysis is old and well known in the insurance industry. For example, when an insured customer is involved in an automobile accident, he or she may submit an estimate for repairs from the body or repair shop to the insurance carrier and thereby file a claim. Therefore, it would have been obvious at the time the invention was made to include claim damage estimate submission requirements to facilitate claims processing."

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,141,611 to Mackey in view of U.S. Patent 6,694,234 to Lockwood.

14. As per claim 1, Mackey teaches a method for estimating vehicle damage, comprising the steps of:

--sensing a vehicle incident via an on-board module (Fig. 2, ele. 24)(see: Mackey, column 2, lines 46-47; and column 3, lines 10-21, is met by accident detector);

--automatically sending vehicle incident data, via a transceiver operatively associated with the on-board module, to a service center (Fig. 1, ele. 16, 18, 19, 20, 25,

and 27)(see: Mackey, column 2, lines 30-40; and column 3, lines 27-34, is met by transmission);

Mackey does not necessarily teach:

--via an estimator at the service center, using the incident data to automatically estimate [[a]] the vehicle damage;

--utilizing the estimated vehicle damage in a vehicle insurance decision process by an insurance service management system.

Though Mackey teaches using vehicle incident data in an insurance related decision (Fig. 1, ele. 25)(see: Mackey, abstract; and column 1, lines 45-49, is met by data utilized by insurance adjuster immediately), Mackey does not necessarily teach estimating vehicle damage. However, Lockwood teaches estimating vehicle damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front quarter panel damage) as part of a response plan implemented at a control center that reacts to distress event detection from vehicle sensors (see: Lockwood, column 3, lines 18-39; and column 3, line 50 through column 4, line 61) that impacts insurance coverage (see: Lockwood, column 1 line 58 through column 2, line 13), the insurance provider host is connected to an operation control center via a communication channel such as the Internet (see: Lockwood, column 5, lines 20-35; and column 5, line 63 through column 6, line 40).

Additionally, Lockwood teaches impact and acceleration/deceleration sensors in a vehicle (see: Lockwood, column 4, line 18 and lines 57-58), a server for responding to sensed data (see: Lockwood, column 6, lines 15-29), and estimating damage (see:

Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front quarter panel damage) for use in an insurance related decision (see: Lockwood, column 8, lines 33-35; and column 8, line 65 though column 9 line 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mackey and Lockwood. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

15. **Claims 2-4** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. U.S. Patent 6,141,611 to Mackey in view of U.S. Patent 6,694,234 to Lockwood in view of U.S. Patent Application Publication 2005/0108063 to Madill further in view of Applicant Admitted Prior Art.

16. As per claim 2, Mackey teaches a method for estimating vehicle damage, comprising the steps of:

--sensing a vehicle incident via a module on-board a vehicle (Fig. 2, ele. 24)(see: Mackey, column 2, lines 46-47; and column 3, lines 10-21, is met by accident detector);

--obtaining, via the on-board module, an incident delta velocity of the vehicle from the vehicle incident (Fig. 2, ele. 24)(see: Mackey, column 2, lines 46-47; and column 3, lines 10-21, is met by accident detector including an accelerometer);

--*sending the incident delta velocity from the on-board module to a service center* (Fig. 1, ele. 16, 18, 19, 20, 25, and 27)(see: Mackey, column 2, lines 14-40; and column 3, lines 27-34, is met by transmission of stored vehicle accident data);

Mackey fails to specifically teach:

--*via the estimator at the service center, using the incident delta velocity with vehicle identification information to automatically estimate a vehicle damage value;*

Though Mackey teaches using vehicle incident data in an insurance related decision (Fig. 1, ele. 25)(see: Mackey, abstract; and column 1, lines 45-49, is met by data utilized by insurance adjuster immediately), Mackey does not necessarily teach estimating vehicle damage. However, Lockwood teaches estimating vehicle damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front quarter panel damage) as part of a response plan implemented at a control center that reacts to distress event detection from vehicle sensors (see: Lockwood, column 3, lines 18-39; and column 3, line 50 through column 4, line 61) that impacts insurance coverage (see: Lockwood, column 1 line 58 through column 2, line 13), the insurance provider host is connected to an operation control center via a communication channel such as the Internet (see: Lockwood, column 5, lines 20-35; and column 5, line 63 through column 6, line 40).

The limitation of *receiving, at an insurance service management system, a claim damage estimate from the service center*; is met by Applicant Admitted Prior Art.

Mackey also fails to teach:

--comparing, via a processor associated with the insurance service management system, the automatically estimated vehicle damage value to the claim damage estimate; and

--in response to the comparison, making an insurance claim-processing related decision.

However, Madill teaches a comparison of at least one data request element disclosed in a claim to additional insurance data (see: Madill, abstract). In addition, based on an assessment such as the one just mentioned, Madill teaches methodology for making investigatory insurance claim-processing related decisions (Fig. 3)(see: Madill, paragraphs 64-65).

Additionally, Lockwood teaches impact and acceleration/deceleration sensors in a vehicle (see: Lockwood, column 4, line 18 and lines 57-58), a server for responding to sensed data (see: Lockwood, column 6, lines 15-29), and estimating damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front quarter panel damage) for use in an insurance related decision (see: Lockwood, column 8, lines 33-35; and column 8, line 65 though column 9 line 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mackey, Lockwood, Madill, and Applicant Admitted Prior Art. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

17. As per claim 3, Madill teaches the claimed step of *making an insurance claim-processing related decision includes requiring an insurance inspection if the automatically estimated vehicle damage value differs by more than a predetermined amount from the claim damage estimate (307 and 309, Fig. 3)*(see: Madill, paragraph 64, is met by the determination to take further investigative action based on a claim if certain indicators surpass a certain threshold).

18. As per claim 4, Madill teaches the claimed step of *making an insurance claim-processing related decision includes omitting an insurance inspection if the automatically estimated vehicle damage value is consistent with the claim damage estimate as (307 and 311, Fig. 3)*(see: Madill, paragraph 65, is met by the determination to not take further investigative action if certain indicators do not meet a certain threshold).

19. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. U.S. Patent 6,141,611 to Mackey in view of U.S. Patent 6,694,234 to Lockwood.

20. As per claim 5, Mackey teaches a system for estimating vehicle damage, comprising:

--a module sensing an occurrence of a vehicle incident and developing incident data responsive thereto (Fig. 2, ele. 24)(see: Mackey, column 2, lines 46-47; and column 3, lines 10-21, is met by accident detector);

--an in-vehicle transceiver for automatically sending vehicle incident data to a service center (Fig. 1, ele. 16, 18, 19, 20, 25, and 27)(see: Mackey, column 2, lines 30-40; and column 3, lines 27-34, is met by transmission);

Mackey fails to specifically teach:

--an estimator within the service center using the incident data to automatically estimate a vehicle damage value; and

--a decision processor providing a business recommendation responsive to the estimated vehicle damage value.

Though Mackey teaches using vehicle incident data in an insurance related decision (Fig. 1, ele. 25)(see: Mackey, abstract; and column 1, lines 45-49, is met by data utilized by insurance adjuster immediately), Mackey does not necessarily teach estimating vehicle damage. However, Lockwood teaches estimating vehicle damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front quarter panel damage) as part of a response plan implemented at a control center that reacts to distress event detection from vehicle sensors (see: Lockwood, column 3, lines 18-39; and column 3, line 50 through column 4, line 61) that impacts insurance coverage (see: Lockwood, column 1 line 58 through column 2, line 13), the insurance provider host is connected to an operation control center via a communication channel such as the Internet (see: Lockwood, column 5, lines 20-35; and column 5, line 63 through column 6, line 40).

Additionally, Lockwood teaches impact and acceleration/deceleration sensors in a vehicle (see: Lockwood, column 4, line 18 and lines 57-58), a server for responding to sensed data (see: Lockwood, column 6, lines 15-29), and estimating damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front

quarter panel damage) for use in an insurance related decision (see: Lockwood, column 8, lines 33-35; and column 8, line 65 though column 9 line 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mackey and Lockwood. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. **Claims 6 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,141,611 to Mackey in view of U.S. Patent 6,694,234 to Lockwood further in view of U.S. Patent Application Publication 2005/0108063 to Madill.

22. As per claim 6, Mackey teaches the invention substantially as claimed, see discussion of claim 5, and further teaches:

--wherein the decision processor provides a recommendation to require further verification of a vehicle insurance claim if the vehicle insurance claim is not consistent with the estimated vehicle damage report.

However, Madill teaches a comparison of at least one data request element disclosed in a claim to additional insurance data (see: Madill, abstract). In addition, based on such an assessment, Madill teaches methodology for making investigatory insurance claim-processing related decisions, including the determination to not take further investigative action if certain indicators do not meet a certain threshold (Fig. 3)(see: Madill, paragraph 64 and 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mackey, Lockwood, and Madill. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

23. As per claim 7, Mackey teaches the invention substantially as claimed, see discussion of claim 5, and further teaches:

--wherein the decision processor provides a recommendation to process a vehicle insurance claim without an insurance inspection if the vehicle insurance claim is consistent with the estimated vehicle damage report.

However, Madill teaches a comparison of at least one data request element disclosed in a claim to additional insurance data (see: Madill, abstract). In addition, based on such an assessment, Madill teaches methodology for making investigatory insurance claim-processing related decisions, including the determination to take further investigative action based on a claim if certain indicators surpass a certain threshold (Fig. 3)(see: Madill, paragraph 64 and 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mackey, Lockwood, and Madill. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

24. Applicant's arguments from the response filed on 05/04/2009 have been fully considered and will be addressed below in the order in which they appeared.

25. In the remarks, Applicant argues in substance that (1) Applicant amendments have overcome the 35 U.S.C. 101 rejections.

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. As per claim 1, the broadest reasonable interpretation of Applicant's "module" recitation is software directed towards recording sensor data - software is not a particular machine. The limitation that teaches "automatically sending vehicle incident data, via a transceiver" is directed toward nominal data gathering. Concerning the limitation that teaches "an estimator" to determine vehicle damage from the incident data, in the specification Applicant states that "an estimator 31, which represents a computerized process that receives the data from the module 40" (Applicant's specification, page 4). Hence the estimator is a process, and given the broadest reasonable interpretation the estimator is considered to be a person working at a computer. The limitation including "utilizing the estimated..." is still not tied to a statutory class. Applicant teaches that the utilizing step is facilitated "by an insurance service management system", but does not teach the particular machine that performs utilizing – "an insurance service management system" is not a particular machine.

26. In the remarks, Applicant argues in substance that (2) the 35 U.S.C. 112, first paragraph, rejections should be withdrawn for the following reasons:

- Factor A: Breadth of claims – “Applicant submits that this claim is not directed to a method of calculating delta velocity. Rather, the incident delta velocity is used to estimate a vehicle damage value.”

The Examiner respectfully disagrees. Applicant's arguments are not persuasive.

The Examiner argued that the invention was directed toward estimating vehicle damage using delta velocity.

- Factor B: Nature of the invention – “The Examiner states that the invention is drawn to estimating vehicle damage by using delta velocity, which is technically complex. Contrary to the Examiner's belief, a calculation of delta velocity is actually very simple and may be determined using very basic principles of physics”.

The Examiner respectfully disagrees. Applicant's arguments are not persuasive.

The two sentences quoted here are in contrast. Applicant correctly states the Examiner's concern that the invention is drawn toward estimating vehicle damage, but then states that the Examiner believes calculating delta velocity is technically complex. It is estimating vehicle damage that is technically complex.

The prior art (including the previously disclosed Kidd, et al. reference, as Applicant points out) shows that calculating delta velocity from a plethora of vehicle damage information is complex, involved, and can be done in many different ways. In this case, vehicle damage is known, delta velocity is not. But this is not what Applicant's invention is directed toward. Applicant's invention

concerns estimating vehicle damage from a known delta velocity. In this case, delta velocity is known, the vehicle damage is not. The prior art shows that calculating delta velocity from known vehicle damage is difficult enough and that there are a variety of different methods employed in determining delta velocity from vehicle damage, and thus indicates that determining vehicle damage from little amount of information conveyed by a known delta velocity would be technically complex if not impossible. Finally, the formula Applicant points out was not found in the specification and is certainly not found in the claims.

- Factor C: State of the prior art – Applicant states that “a method of estimating a value using a look up table or database has been used for many years and may be applied to a number of different application. For example, look up tables may be used to determine geographic coordinate of a desired area or region, to determine the amount of sales tax in a particular state for a purchased item or good, and the like. Likewise, a look up table may similarly be constructed including vehicle damage values.”

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. How look up tables work and that they have been previously used and therefore would be obvious to use for Applicant's purpose is not the Examiner's concern. Applicant states that a look up table could be constructed for Applicant's purpose, but how? Where do the estimations come from, how were they put into the table, how is the table formatted or constructed, how did Applicant estimate vehicle damage using delta velocity, what calculations, variable, metrics, and equations

are involved, and what measurement units were used? The prior art shows no such table being used to estimate vehicle damage by way of a delta velocity look up table.

- Factor D: Level of ordinary skill – Applicant states "that in light of the simple delta velocity calculation provided above, basic mathematical skill (e.g., an elementary school student) would be required to determine the delta velocity".

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. Firstly, algebraic skills are rarely practiced by elementary school students, and algebraic concepts are normally first addressed by students in middle school but sometimes not even until high school. Secondly, calculation of delta velocity is not the issue – Applicant teaches that delta velocity is known and is used in an estimation of vehicle damage. Instead, how is vehicle damage estimated using delta velocity?

- Factor E: Level predictability in the art – Applicant states that computer programs are used by Applicant's invention to estimate vehicle damage; hence, "substantially no subjectivity is used to determine the vehicle damage value according to Applicant's method".

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. This factor was used to show that people (e.g., adjustors in the insurance business or specialists in the automotive business) with specialized skills previously performed these functions. Previously, estimating vehicle damage was an art performed by experienced human beings and the result of said evaluation

by a human being cannot be assured and requires a particular skill. If Applicant is to distill estimating vehicle damage down to a science, Applicant must disclose how vehicle damage estimates are determined from delta velocity.

- Factor F: Amount of direction provided by the inventor – Applicant states that sufficient guidance is provided and summarizes: “the delta velocity (calculated, e.g., by the simple equation provided above) and vehicle identification information (e.g., vehicle model) is used by an estimator (e.g., a computer program) at the service center to determine the vehicle damage value from the look up table or database (see page 4, lines 3-13 of Applicant's specification as filed)”.

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. Applicant states that information including delta velocity is *used* by an estimator to determine vehicle damage, but *how* is that information used? There is insufficient direction provided in Applicant's specification. A mere statement that it is *done* is insufficient to show possession.

- Factor G: Existence of working examples – “Applicant submits that the exist existence of working examples in the specification is only one factor considered for a determination of a lack of enablement. To reiterate from above, all of the factors must be weighed to determine if an enabling disclosure is not present. In light of the discussion herein in regard to the other factors, Applicant submits that the lack of a working example does not itself render the application non-enabled”.

The Examiner respectfully disagrees. Applicant's arguments are not persuasive.

All of the factors have been weighed. Applicant did not provide working examples.

- Factor H: Quantity of experimentation needed to make or use the invention based on content of the disclosure – "Applicant submits that the vehicle damage value is estimated by looking the value up in the database or look up table" and "Applicant submits that such estimation of the vehicle damage value would actually be relatively straight forward."

The Examiner respectfully disagrees. Applicant's arguments are not persuasive.

Based on the content of the disclosure, an undue amount of experimentation would be required to, in any way, estimate vehicle damage; therefore, and undue amount of experimentation would be need to make or use Applicant's invention.

27. In the remarks, Applicant argues in substance that (3) 35 U.S.C. 112, second paragraph, rejection to claim 2 should be withdrawn in view of amendment and explanation that the delta velocity "of the vehicle" is obtained.

The rejection has been withdrawn.

28. In the remarks, Applicant argues in substance that (4) 35 U.S.C. 112, second paragraph, rejection to claims 1, 2, and 5 should be withdrawn and Applicant "submits that the Examiner is making the method of estimating the vehicle damage value too complicated. The method is actually quite simple, whereby the incident data is used as an input of the look up table, from which the vehicle damage value is retrieved".

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. Applicant does not teach the steps of using incident data to determine vehicle damage - the steps are missing. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., look up tables) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

29. In the remarks, Applicant argues in substance that (5) 35 U.S.C. 103(a) rejections should be withdrawn because Lockwood fails to teach that the estimating is done at a service center.

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. Lockwood teaches an operation control center which meets Applicant's service center. At Lockwood's control center, vehicle sensor data is received in a vehicle distress event and the response plan is generated.

Additionally, where the estimation of vehicle damage is calculated is a matter of design choice; Applicant's admission in the specification, page 6, last paragraph, states: "The above example shows the estimator 31 and database 32 as part 20 of service center 30. It will be evident to those skilled in the art that these functions can be implemented instead within the service center represented by the insurance service management subsystem 37 and that the data from the vehicle can be transmitted to the insurance service management subsystem 37 either directly or indirectly by way of

service center 30." Hence, the estimation need not be done at the service center.

Where the estimation is generated is a matter of design choice, and the arrangement of specific elements in the prior art need not be exactly the same as those presented in the claims - see section 2144.04 of the MPEP.

30. In the remarks, Applicant argues in substance that (6) 35 U.S.C. 103(a) rejections should be withdrawn because the cited prior art fails to teach that the estimating is done using delta velocity and vehicle identification information.

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. Firstly, indeed claim 2, for example, teaches that the estimation is calculated *using* incident delta velocity and vehicle identification. The term *using* is given its broadest reasonable interpretation and Applicant has not taught how this information is used (see discussion of argument 1 and the 35 U.S.C. 112, first paragraph, rejections). Mackey teaches a vehicle identification code (see: Mackey, column 2, lines 53-56) and Lockwood teaches a plethora of information including customer profile and insurance coverage (see: Lockwood, column 9, lines 27-31; and column 9, lines 50-57) as well as a plethora of vehicle sensors all conveying many types of vehicle identification information (see: column 3, line 56 through column 4, line 61). Lockwood also teaches reserving a rental car that is "comparable to the type involved in the loss or referenced in the customer profile" (see: Lockwood, column 9, lines 44-46); hence, Lockwood teaches vehicle identification.

31. In the remarks, Applicant argues in substance that (7) 35 U.S.C. 103(a) rejections should be withdrawn because Applicant's "value" is not met by Lockwood

because Applicant's "vehicle damage value refers to a numerical estimate of the vehicle damage sensed by the on-board module. Such vehicle damage value is in sharp contracts to the vehicle damage (the actual, physical damage) sensed by the sensors in Lockwood".

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a range of actual damage values consistent with the data recorded by module 40") are not recited in the rejected claim(s). The term "value" is given its broadest reasonable interpretation, and Applicant has failed to claim what, exactly, this value is a measure of or what quantifiable unit it is measured in. Lockwood teaches many damage "values" – see the list of sensors (see: Lockwood, column 3, line 56 through column 4, line 61) and the types of data they produce including G-Force, altimeter, and rapid acceleration and deceleration – these sensors produce values that define a vehicle incident and trigger an insurance process. In fact, in the examples, Lockwood teaches that these values are enough to make the determination as to if the vehicle incident is a "total loss" (a monetary value assessment) or if only "the front end and right front quarter panel have been damaged".

Additionally, Applicant has failed to consider the main reference, Mackey. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Mackey teaches accelerometers which sense "accident signature values". If there is any more to be gleaned from Applicant's definition of "value" it is not present in the claims.

Conclusion

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

33. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ROBERT SOREY** whose telephone number is (571)270-3606. The examiner can normally be reached on Monday through Friday, 8:30AM to 5:00PM (EST).

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on (571)272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. S./
Examiner, Art Unit 3626
13 August 2009

/C. Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626